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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,392	11/28/2000	Karen Moore	MPI97-O18CP1DV1M	9536

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MURPHY, JOSEPH F

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1646

DATE MAILED: 11/04/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/724,392	MOORE ET AL.	
	Examiner	Art Unit	
	Joseph F Murphy	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 October 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-88 is/are pending in the application.
- 4a) Of the above claim(s) 16-31 and 47-88 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 32-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group V, claims 32-46 in Paper No. 10, 10/16/2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 16-88 are pending. Claims 16-31, 47-88 are withdrawn from consideration pursuant to 37 CFR 1.142(b).

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Applicant should restrict the title to the claimed invention.

Applicant should avoid the use of novel in the title, as patents are presumed to be novel and unobvious.

Claim Rejections - 35 USC §§ 101, 112, first paragraph

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-46 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed patentable utility. The instant application has provided a

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description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose the biological role of this protein or its significance, therefore the claimed method of identifying a compound is not supported by either a credible, specific and substantial asserted utility or a well established utility. Novel biological molecules lack well-established utility and must undergo extensive experimentation. Applicant is directed to the Utility Examination Guidelines, Federal Register, Vol. 66, No. 4, pages 1092-1099, Friday January 5, 2001.

According to MPEP § 2107, a rejection for lack of utility is imposed when an invention lacks an asserted specific and substantial utility for the claimed invention and it does not have a readily apparent well-established utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.

It is clear from the instant specification that the I5E polypeptide has been assigned a function because of its similarity to known proteins (Specification at 18, line 11). However, it is commonly known in the art that sequence-to-function methods of assigning protein function are prone to errors (Doerks et al. 1998). These errors can be due to sequence similarity of the query region to a region of the alleged similar protein that is not the active site, as well as homologs that did not have the same catalytic activity because active site residues of the characterized family were not conserved (Doerks et al. page 248, column 3, fourth and fifth paragraphs). Inaccurate use of sequence-to-function methods have led to significant function-annotation errors in the sequence databases (Doerks et al. page 250, column 1, third paragraph). Furthermore,

Brenner (1999, Trends in Genetics 15:132-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different molecular and cellular functions. Finally, Bork et al. (1996, Trends in Genetics 12:425-427) add that the software robots that assign functions to new proteins often assign a function to a whole new protein based on structural similarity of a small domain of the new protein to a small domain of a known protein. Such questionable interpretations are written into the sequence database and are then considered facts.

Additionally, even if, *arguendo*, the I5E protein is found to be a G-protein coupled receptor, it is an orphan receptor. Since the ligand to this receptor is unknown, the function of the protein is also unknown. Neither the specification nor the art of record disclose any diseases or conditions associated with the function or expression of the I5E protein, therefore, there is no "real world" context of use. Further research to identify or reasonably confirm a "real world" context of use is required. In the instant case, the fact that the claimed invention is a method of identifying a compound which modulates a GPCR is not sufficient to establish a specific and substantial utility. Although GPCRs have been found to be involved in many different processes and have been the target of much research and drug discovery, unless the specific ligand for each receptor is known, unless the biological activity of the receptor is disclosed and unless the processes that each receptor is involved in are identified, the a method of identifying a compound which modulates a receptor has no "real world" use, and therefore, lacks specific and substantial utility.

After complete characterization, this protein may be found to have a patentable utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 USPQ 689 (Sup. Ct., 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anticancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 USC § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

The instant claims are drawn to a nucleic acid encoding a polypeptide which has an as yet undetermined function or biological significance. Until some actual and specific significance

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can be attributed to the protein identified in the specification as I5E, the instant invention is incomplete. The polypeptide encoded by the nucleic acids of the instant invention is known to be structurally analogous to proteins that are known in the art as G protein coupled receptors. In the absence of knowledge of the natural substrate or biological significance of this protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the identification of substances which inhibit or increase its activity is clearly to use it as the object of further research which has been determined by the courts to be a non-patentable utility. Since the instant specification does not disclose a "real world" use for I5E then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 USC § 101 as being useful.

Claims 32-46 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Even if, *arguendo*, the method of identifying a compound to I5E is found to have a patentable utility, claims 32-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention.

The specification does not disclose the nexus between the I5E polypeptide and an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders multiple sclerosis or depression, therefore the claims as written which are directed to methods of identifying compounds which bind and affect I5E activity, are not enabled.

Since the claims do not disclose the nexus between I5E polypeptide and an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders multiple sclerosis or depression, it would require undue experimentation to practice the claimed method. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. The factors considered in the instant case are set forth below:

(1) the breadth of the claims - The claims are drawn to a method for identifying a compound capable of treating an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression by measuring the effect on I5E expression.

(2) the nature of the invention - The instant invention is a method of compound identification.

(3) the state of the prior art - the prior art teaches recognized methods of treatment of an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression in the Merck Manual (pages 1022-1034, 1564-1571, 1474-1476, 1531-1538). The Merck Manual does not disclose the nexus between I5E and an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression by measuring the effect on I5E expression.

(4) the level of one of ordinary skill - A medical professional would be considered one of ordinary skill in this art.

(5) the level of predictability in the art - the art is such that absent *in vivo* clinical data it would require undue experimentation to practice this method for identifying a compound capable

of treating an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression by measuring the effect on ISE expression.

(6) the amount of direction provided by the inventor - the specification has provided insufficient guidance to methods for identifying a compound capable of treating an immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression by measuring the effect on ISE expression. The Specification has not provided the nexus between the etiology of immune, central nervous system or metabolic disorder, schizophrenia, cognitive disorders, multiple sclerosis or depression and ISE expression

(7) the existence of working examples - Working examples are not provided.

(8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. Given the breadth of claims 32-46 in light of the predictability of the art as determined by the number of working examples, the level of skill of the artisan, and the guidance provided in the instant specification and the prior art of record, it would require undue experimentation for one of ordinary skill in the art to practice the claimed invention.

Conclusion

No claim is allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
October 30 , 2002